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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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38/325,189 06/03/99 KINJO

M 990360/LH

| EXAMINER |
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HM12/0919

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NEW YORK NY 10017-2023

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1656  
DATE MAILED:

19  
09/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Advisory Action

Application No.  
09/325,189

Applicant(s)  
Kinjo

Examiner  
Joyce Tung

Art Unit  
1656



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 2/2001 and 8/1/2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☒ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Please see the attached.

4. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
Please see the attached.  
\_\_\_\_\_  
\_\_\_\_\_
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: claims 1-8
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☒ Other: interior drawing is paper #19, 14 and 15

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1. The proposed amendment in claims 1, 3 and 4 as filed 7/12/2001 and 8/1/2001, "a fluctuation motion" raises new issues that would require further consideration and/or search. Thus, the proposed amendment has not been entered.

2. The response filed 7/12/2001 and 8/1/2001 has been fully considered, because the response raises new issues regarding "a fluctuation motion", the prior art provided is still applicable to the rejection. Although the response filed 7/12/2001 argues that in claim 1 steps (a) to (d) are performed in a test solution, while the teachings of Mullis et al. and Clive et al. are directed to detecting movement of a nucleic acid sequence in a solid phase by electrophoresis, electrophoresis has to be performed in a solution which was well known in the art at the time of the instant invention. The limitation regarding detecting the movement of a nucleic acid in a test solution is not clearly presented in the claim language. Thus, the prior art provided is still applicable to the rejection and the rejection is maintained.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullis et al. (4,965,188) in view of Clive et al. (J. Neurosci. Methods, 1998, Vol. 81, pg. 25-34).

4. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached at (703) 308-1152.


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Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

5. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

September 14, 2001

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600

9/18/01